



*Patricia Lewis*  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Patent Application of  
FRANK PELOSI, JR.

Serial No. 09/395,270

Filed: September 13, 1999

For: Dimensionally Stable Adhesive  
Floor Covering System

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Group Art Unit 3634

Examiner Blair M. Johnson

I hereby certify that this document is being deposited with  
the U.S. Postal Service as first class mail in an envelope  
addressed to: Assistant Commissioner for Patents,  
Washington, D.C. 20231, on 10/18/2001

*Norman E. Lehrer*  
Norman E. Lehrer, Reg. No. 26,561

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APPELLANT'S BRIEF ON APPEAL

Pursuant to 37 C.F.R. §1.192, Appellant hereby presents his brief on appeal from  
the Primary Examiner's Final Rejection. A timely filed Notice of Appeal was received in the  
Patent and Trademark Office on September 14, 2001.

1. REAL PARTY IN INTEREST

The real party in interest is Relay, L.L.C.

2. RELATED APPEALS AND INTERFERENCES

Appellant and Appellant's legal representative are unaware of any other appeals  
or interferences which will directly affect or be directly affected by or have a bearing on the  
Board's decision on the pending appeal.

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3. STATUS OF THE CLAIMS

Claims 1-10 are pending in the application. Claims 1-10 stand rejected and are on appeal.

4. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

5. SUMMARY OF INVENTION

The present invention essentially includes a flexible backing 12 with a top side 14 and a bottom side 16. An adhesive 18 may be applied to the top side 14 and an adhesive 20 may be applied to the bottom side 16 of the backing 12. Alternatively, an adhesive may be applied to only one side of the backing. Release paper 22 is placed on the adhesive 18 of the top side 14 and release paper 24 is placed on the adhesive 20 of the bottom side 16 of the backing 12.

The adhesive is preferably a pressure sensitive adhesive, however, other adhesives well known in the art may be used. Also, the adhesive applied to the top side 14 of the backing 12 may be different from the adhesive applied to the bottom side 16 of the backing 12.

The backing 12 is a fibrous and non-woven material. It is generally not in a grid pattern. The backing 12 may be made from a non-woven plastic film such as the non-woven, spun-bonded polyethylene film sold under the trade name Tyvek and manufactured by E. I. du Pont de Nemours and Company, Wilmington, Delaware. (See the specification at page 5, lines 20-22.) The backing may also be made from Tyvar which is a spun-bonded, non-woven fabric of polypropylene composed of randomly arranged, continuous filament fibers bonded at filament cross-over points available from Norville Industrials, Dalton, Georgia. Alternatively, the backing

may be made from a thin, flexible but dimensionally stable plastic material, such as Mylar.

Preferably, when the backing is made from Tyvek, Typar, or similar material, the backing has a thickness of less than 10 mils and more preferably, less than 6 mils so that the same functions solely as a dimensional stabilizer rather than functioning to add additional padding or the like.

When the backing is made from Mylar or similar material, the backing has a thickness of approximately 1-2 mils, and preferably, approximately 1 mil. (See the specification at page 6, lines 4-10.)

In order to use the sheet 10 of the present invention, the release paper 24 from the bottom side 16 of the backing 12 is removed. The bottom side 16 of the backing 12 is then placed on an existing carpet or cushion 26 or any subfloor, such as a concrete floor. The release paper 22 on the top side 14 of the backing 12 is removed as carpet tiles 30a, 30b, and 30c, for example, are placed on the adhesive 18 of the top side 14 of the backing 10. The result is a floor 32 having a pre-existing carpet 26 covered with carpet tiles as seen in Figure 5. In this manner, the pre-existing carpet 26 becomes dimensionally stable and is impervious to movement which takes place on the carpet tiles. Thus, with the present system it is possible to install cut pieces, or tiles, of broadloom carpet over flexible subfloors such as existing carpet or cushion. It is also possible to install large sheets of broadloom carpet, instead of carpet tiles, on a subfloor.

## 6. ISSUES

The issues are whether Claims 1-8 and 10 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,902,658 to Wyman; whether Claims 1-8 and 10 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,902,658 to Wyman in view of the SIGA brochure; whether Claim 8 is unpatentable under 35 U.S.C. §103(a) over U.S. Patent No.

5,902,658 to Wyman in view of the Shaw Bulletin No. 82; whether Claim 9 is unpatentable under 35 U.S.C. §103(a) over Wyman, either alone or in view of the SIGA brochure and further in view of U.S. Patent No. 5,601,910 to Murphy et al.; whether Claims 1-4 and 6-8 are anticipated under 35 U.S.C. §102(b) by the Shaw Bulletin No. 82; whether Claims 5 and 10 are unpatentable under 35 U.S.C. §103(a) as being unpatentable over the Shaw Bulletin No. 82 in view of U.S. Patent No. 5,902,658 to Wyman; and whether Claim 9 is unpatentable under 35 U.S.C. §103(a) over the Shaw Bulletin No. 82 in view of U.S. Patent No. 5,601,910 to Murphy et al.

7. GROUPING OF CLAIMS

Appellant does not believe that all of the claims stand or fall together. Appellant believes that the claims should be grouped as follows:

A. Claims 1-4, 6-8, and Claim 10;

B. Claim 5; and

C. Claim 9.

Appellant believes that each of the above groups is separately patentable from each other.

8. ARGUMENT

The Examiner has rejected Claims 1-8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Wyman. According to the Examiner, Wyman discloses a polymer backing having a double layer of adhesive and release films therefor. The Examiner states that it would have been within the purview of one of ordinary skill in the art to first place the backing on the underlying surface, carpet, concrete, etc., and then place the top carpet or rug thereon, such being

an obvious choice of sequence of steps. Also, the Examiner states that using different types and/or strengths of adhesive for the different sides of the backing would have been obvious so as to better adhere to the intended surfaces and that the backing is applicable to carpets, rugs, or carpet tiles. The Examiner also states that the thickness of the backing is an obvious variant depending on the application surface, the carpet to be used, etc. Appellant respectfully disagrees.

Wyman discloses a rug underlay which includes a water impervious woven web of flat monofilament yarn with adhesives coated thereon. Wyman does not disclose, suggest, or render obvious Appellant's method for applying a carpet to a subfloor. The method disclosed in Wyman does not disclose the steps of providing a dimensionally stable sheet, placing the sheet on an existing subfloor, and then placing a carpet on the sheet as recited by the Appellant. The Examiner believes these steps are an obvious choice of sequence of steps. Appellant strenuously disagrees with the Examiner's conclusion. As explained in the Appellant's specification, for example, at page 6, lines 18-20, by placing Appellant's sheet on the existing subfloor, the existing subfloor becomes dimensionally stable and is impervious to movement which takes place on the carpet that is placed on top of the sheet. The underlay disclosed in Wyman, however, is not placed on the existing subfloor. Rather, the underlay is placed on a rug to be laid down on an existing carpet. This rug may be easily removed as needed. This method does not provide for the dimensional stability produced by Appellant's method. Therefore, the sequence of Appellant's steps are critical and are not merely an obvious design choice.

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Appellant also disagrees with the Examiner's statement that the thickness of the backing is an obvious variant depending on the application surface. Again, as Appellant states in the specification, for example at page 6, and lines 5-10, the particular thickness of the backing is

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important in functioning as a dimensional stabilizer. It is not an obvious variant as suggested by the Examiner.

The Examiner also rejects Claims 1-8 and 10 under 35 U.S.C. §103(a) as being unpatentable over Wyman in view of the SIGA brochure. The Examiner states that while Wyman primarily teaches applying a rug to a carpet, using a backing having a release sheet to mount a carpet to a floor is well known as evidenced by the SIGA brochure. The Examiner states that based on the teaching in the SIGA brochure, it would have been obvious to modify Wyman whereby the backing in Wyman is used to attach a carpet to a floor surface. Appellant again respectfully disagrees.

As discussed above, Wyman does not disclose Appellant's method. The SIGA brochure adds little, if anything to the teaching of Wyman. That is, the SIGA brochure discloses a method for installing carpet. While the brochure may teach the use of a backing with a release sheet where the backing is mounted to a floor, there would be no reason to combine this teaching with the teaching of Wyman. That is, Wyman discloses a method for mounting an underlay to a rug where the underlay is placed on the rug to be laid. The SIGA method, however, discloses placing a backing on a floor surface to be carpeted. There simply is no reason to modify Wyman which teaches a method for securing an underlay to a rug which may be repositioned or relocated as desired with the teaching of the SIGA brochure which discloses a method for installing carpet on a floor surface which is more of a permanent procedure. In fact, to modify the teaching of Wyman as suggested by the Examiner would destroy the reference in that Wyman is directed toward a rug which is laid on top of a carpet and can be easily repositioned or replaced. Using the method disclosed in the SIGA brochure in Wyman, would not allow the functions of Wyman

discussed above. Therefore, Appellant's invention as recited is not rendered obvious by these references.

The Examiner has rejected Claim 8 under 35 U.S.C. §103(a) as being unpatentable over Wyman in view of the Shaw Bulletin No. 82. The Examiner states that Shaw indicates that a backing sheet may be attached to existing carpets as well as new or existing concrete slabs. The Examiner further states that while it is considered that such is obvious, Shaw provides further evidence of such and applying the backing of Wyman to a concrete surface would have been obvious in view thereof. Appellant respectfully disagrees.

Wyman does not disclose or render obvious Appellant's claimed method as discussed above. The Shaw bulletin adds little, if anything, to the teaching of Wyman. The Shaw bulletin discloses a method for installing carpet which includes unrolling a roll of mesh onto a floor, removing the liner from the mesh, and then placing a carpet on the mesh. There would be no reason to combine the teaching of the Shaw bulletin with Wyman. As discussed above with regard to the SIGA brochure, the Shaw bulletin also discloses a method for installing carpet. To combine this teaching with Wyman which teaches securing an underlay to a rug where the rug may be repositioned or relocated would not be obvious. Also, it would defeat the ability of the underlay disclosed in Wyman to be repositioned or relocated.

The Examiner has rejected Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Wyman, either alone or in view of the SIGA brochure, and further in view of Murphy et al '910. The Examiner states that Murphy et al. disclose a backing sheet comprising various non-woven polymers, which indicates that a woven backing is not the only means by which the backing can be constructed. According to the Examiner, it would have been obvious to

modify Wyman to have such a backing as an obvious matter of choice of design. Appellant respectfully disagrees.

Wyman does not disclose or render Appellant's claimed method obvious for the reasons discussed above. The Murphy et al. reference does not add anything to the teaching of Wyman. That is, assuming that Murphy et al. has been properly combined with Wyman, Appellant's invention would not result. Again, Wyman discloses a method for mounting an underlay to a rug where the underlay is placed on the rug to be laid. Murphy et al. disclose a rug underlay comprising a fibrous non-woven substrate with a repellent finish which makes the substrate impervious to liquids. It does not disclose Appellant's claimed method. Combining these two references would not result in Appellant's method of applying a carpet to a subfloor. Furthermore, neither of these references discloses Appellant's claimed backing made from a spun-bonded, non-woven fabric with a thickness of approximately 8 mils. Neither is such a fabric an obvious design choice. As discussed above, the particular fabric and thickness of the backing is important to Appellant's invention in providing a dimensionally stable sheet.

The Examiner responds to Appellant's arguments by stating that Murphy et al. is analogous art. Appellant assumes that the Examiner is stating such in order to draw the conclusion that, therefore, Murphy et al. has been properly combined with Wyman. While Appellant does not agree or disagree with this conclusion, his argument is merely that even by combining the two references, Appellant's method, as claimed, will not result as discussed above and in the Request for Reconsideration filed on September 18, 2000.

Claims 1-4 and 6-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by Shaw Bulletin No. 82. The Examiner states that Shaw discloses a backing system



which uses pressure sensitive adhesive which has been applied to the backing which adheres to the subfloor and the carpet. The Examiner goes on to state that the top surface of the backing has a plastic release liner and that the backing may be used over existing carpets or concrete.

Furthermore, the Examiner states the backing system may be used with sheet carpet and carpet tiles and that the method disclosed in the reference includes the steps recited in Appellant's Claim 1. Appellant respectfully disagrees.

As stated above, the Shaw bulletin discloses a method for installing carpet which includes unrolling a roll of mesh onto a floor, removing the liner from the mesh, and then placing a carpet on the mesh. This method lacks Appellant's recited step of providing a dimensionally stable <sup>SHEET</sup> screen. That is, the mesh disclosed in this reference is not a dimensionally stable <sup>SHEET</sup> screen.

Therefore, Appellant's method is not taught by the Shaw reference.

Claims 5 and 10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Shaw Bulletin No. 82 in view of Wyman. The Examiner states that the backing of Shaw is comprised of a material which provides a pressure sensitive adhesive on both sides thereof but that it is not clear if the adhesive properties are the result of coating each side separately. The Examiner states, however, that Wyman does disclose providing two separate layers of adhesive to the backing and that while they are of the same strength, modifying one of the adhesives to be of lesser strength would have been obvious since different holding powers are required due to the different surfaces to which the backing is to be attached. The Examiner concludes, therefore, that in view of this teaching, it would have been obvious to modify Shaw to have two separate layers of adhesive of different strengths. The Examiner also states that Wyman discloses plastic material for his backing and that while the material from which the Shaw

backing is constructed is not disclosed, using plastic as taught by Wyman would have been obvious due to the advantages plastic has in such a use. The Examiner also states that the thickness would have been a design choice obvious to one of ordinary skill in the art as a result of routine experimentation. Appellant respectfully disagrees.

Neither of the references relied upon by the Examiner teaches or suggests Appellant's invention as discussed above. Those comments are applicable here and will not be repeated. Appellant disagrees with the Examiner's comments that modifying the adhesives disclosed in Wyman to include two different adhesives in the invention disclosed in the Shaw reference is an obvious variation. There is nothing in Wyman that teaches or suggests using two different types of adhesive on its backing. To then further modify the Shaw reference to include such a modified feature of Wyman as the Examiner does is improper. Again, for all of the reasons stated above, to combine the teachings of the references relied upon the Examiner would not result in Appellant's invention.

Also, even if it would be obvious to modify the Shaw reference to include the use of plastic, the Shaw reference still does not provide Appellant's recited step of providing a dimensionally stable screen. Therefore, Appellant's claimed invention is not rendered obvious by the references relied upon by the Examiner.

The Examiner has rejected Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Shaw Bulletin No. 82 in view of Murphy et al. as applied above Appellant disagrees for the reasons discussed above.

In view of all of the foregoing, Appellant submits that all of the claims presently in the application clearly and patentably distinguish over the references of record and should be allowed.

Respectfully submitted,

FRANK PELOSI, JR.

By:

Norman E. Lehrer

Registration No. 26,561

Dated: November 14, 2001

## APPENDIX

1. A method of applying a carpet to a subfloor comprising the steps of:  
providing a dimensionally stable sheet having a backing with a top side and a bottom side, said backing being made from a material and having adhesive applied to at least one of said top or bottom sides;  
placing said sheet on an existing subfloor;  
providing a carpet; and  
placing said carpet on said sheet.
2. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said adhesive is applied to both top and bottom sides of said backing.
3. The method of applying a carpet to a subfloor claimed in Claim 2 further including the step of placing release paper on at least one of said top or bottom sides of said backing.
4. The method of applying a carpet to a subfloor claimed in Claim 3 further including the step of removing said release paper from said backing.
5. The method of applying a carpet to a subfloor claimed in Claim 2 wherein the adhesive applied to said top side of said backing is different from the adhesive applied to said bottom side of said backing.
6. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said carpet is a carpet tile.

7. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said subfloor is an existing carpet.

8. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said subfloor is a concrete floor.

9. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said backing is made from a spun-bonded, non-woven fabric having a thickness of approximately 8 mils.

10. The method of applying a carpet to a subfloor claimed in Claim 1 wherein said backing is made from a thin, flexible plastic material having a thickness of approximately 1 mil to approximately 2 mils.